

REMARKS

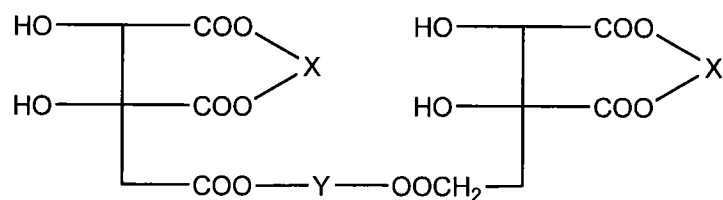
Applicants thank Examiner Valenrod for the review of the pending application. Claims 1 and 12 are currently amended, and claim 20 is added. No new matter is added.

35 U.S.C. § 102(b) Rejections

Claims 1, 2, 5 and 19 are finally rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 6,221,901 ("Shrivastava"). Applicants respectfully traverse this rejection.

Independent claim, as amended, 1 recites:

Double metal salts of (–)-hydroxycitric acid (HCA) as shown in the general formula I



wherein X and Y are independently selected from metals of group II (IIA & IIB) of the Periodic Table. (emphasis added)

A "double metal salt" as claimed in described in the pending application is a salt having at least two different metals. The language "double metal salt" is in original claim 2, which depends from claim 1. The concept of a double metal salt is exemplified in each of Examples 1-4, wherein X is different from Y. New claim 20 is added to provide clarification by expressly reciting that X is different from Y. This amendment is supported by the specification, which describes and exemplifies only chemical structures wherein X and Y are different. Examples 1 and 2 exemplify the two different metals being calcium and magnesium. Example 3 shows the two different metals to be magnesium and zinc. Example 4 shows the different metals to be calcium and zinc.

Shrivastava, by contrast, does not disclose a double salt where X and Y are different. Rather, in Shrivastava, both X and Y are both magnesium. See Shrivastava col. 4, lines 32-43; Declaration, paragraphs 4-8. This is because Shrivastava discloses a physical blend of the

magnesium hydroxycitrate and the zinc in ionized or nonionized form. This will not inherently result in a double salt as claimed because the zinc ions that are disclosed in Shrivastava are not soluble in water (unlike the present application which is an acidic solution with free COOH moieties in solution) and the ionic potential of the Shrivastava zinc ions is insufficient to displace a magnesium ion. In normal conditions such as those disclosed in Shrivastava, a magnesium ion could displace a zinc ion, but not the reverse. See Declaration, paragraphs 4-6.

Against this backdrop, the Examiner's anticipation-by-inherency argument cannot stand. Specifically, the Examiner has not provided objective evidence or cogent technical reasoning to support the conclusion that Shrivastava inherently discloses the double salts of the pending claims. MPEP 2112. Thus, Shrivastava does not anticipate claim 1, nor does it anticipate the claims that depend therefrom. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b).

35 U.S.C. § 103(a) Rejections

Claims 1-5, 12-16 and 19 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shrivastava. Applicants traverse this rejection.

The double metal salts of the pending claims are not obvious. This is because an obvious-to-try rationale can only support a rejection under § 103 in the limited situations where there "are a finite number of identified, predictable solutions, [and] a person of ordinary skill has good reason to pursue the known options within his or her technical grasp." See *KSR Int'l Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1397 (2007).

This is not a predictable art with a finite number of predictable solutions. In fact, as admitted by the Examiner in the non-final Office Action, "altering the counter ion of a carboxylic acid salt can have a profound effect on the physical properties of that salt." (Non-final Office Action, page 5). Thus, one of skill in this art would have no reason to modify the teachings of Shrivastava, which does not disclose any activity relating to osteoporosis, to arrive at the claimed double metal salt compound which has been discovered to have utility in the treatment in osteoporosis. Accordingly, claim 1 is not obvious over the cited reference. Claims 2-5 and 12-20 depend from claim 1, so they cannot be rendered obvious over the cited reference for at least the

reasons mentioned above. Thus, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 103.

CONCLUSION

Applicants believe that any fee due with this response is identified in an accompanying transmittal. However, if any additional fee is due, please charge our Deposit Account No. 18-0013, under Order No. DAD-0013 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136 is hereby made, the fee for which should be charged to such deposit account number.

Dated: June 29, 2009

Respectfully submitted,

By /Linda D. Kennedy/
Linda D. Kennedy

Registration No.: 44,183
RADER, FISHMAN & GRAUER PLLC
Correspondence Customer Number: 10291
Attorney for Applicant